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OFFICE OF PETITIONS

ON PETITION

In re Application of
Barbarella, et al
Application No. 09/540,659
Filed: 31 March, 2000
Attorney Docket No. 3797IN-1

This is a decision on the petition filed on 1 August, 2003, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, it also is noted that Petitioner filed the papers in the continuation (09967,057), rather than the instant application.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and 30 May, 2001, final Office action, with a reply due absent a request and fee for extension of time on Thursday, 30 August, 2001;
- a result, the application was deemed abandoned after midnight 30 August, 2001;
- Notice of Abandonment was mailed on 8 March, 2002;

- however, Office records also reflect that Petitioner filed on 28 September, 2001, a continuation-in-part (now identified as Application No. 09/967,057 (the '057 application)), along with a request and fee authorization for extension(s) of time as required—in this case, one month;
- it appears that Petitioner was not aware that the instant matter had been deemed abandoned after midnight 30 August, 2001, until he was denied priority in the '057 application, and at that time improvidently filed the instant petition in the '057 application, rather than the parent;
- the instant petition was accompanied by: the statement of Petitioner Joseph Kovarik (Reg. No. 33,005) and copies of documents as to the instant application and the '057 application.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶)

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷ (However, a delay is not "unavoidable" when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.⁸)

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.⁹

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹⁰

Petitioner has evidenced timely and proper reply to the Office action, and so satisfies the showing as required under 37 C.F.R. §1.181.

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

⁸ See MPEP 711.03(c)(III)(C)(2).

⁹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

¹⁰ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

C.F.R. §1.181 hereby is granted, , and the one-month extension of time previously uncharged hereby is charged as authorized to Deposit Account 19-1970.

The file is forwarded to the Technology Center 1700 to correct Office records to reflect that the instant application was in fact co-pendent with the continuation in part Application No. 09/967,057, and for such processing as required in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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